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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

KIM, AHSHIK

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 05/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/825,380

Applicant(s)

MADRID ET AL.

Examiner

Ahshik Kim

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02/26/03 (Amendment) .
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____ .

DETAILED ACTION

Amendment

1. Receipt is acknowledged of the amendment filed on February 26, 2003. In the
5 amendment, claims 2, 3, and 10 were amended. Currently, claims 1-17 remain for examination.
As previously discussed, and as indicated in the first part of remarks section, previous Office
Action (paper #8) was non-final.

Claim Rejections - 35 USC § 102

10 The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the
basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- 15 (e) the invention was described in-
(1) an application for patent, published under section 122(b), by another filed in the United States before
the invention by the applicant for patent, except that an international application filed under the treaty
defined in section 351(a) shall have the effect under this subsection of a national application published
under section 122(b) only if the international application designating the United States was published under
Article 21(2)(a) of such treaty in the English language; or
20 (2) a patent granted on an application for patent by another filed in the United States before the invention
by the applicant for patent, except that a patent shall not be deemed filed in the United States for the
purposes of this subsection based on the filing of an international application filed under the treaty defined
in section 351(a).

25 2. Claims 1-3, 10-14, 16, and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by
Inose (US 6,385,407).

Re claim 1, Inose teaches a smart container 100 (col. 3, lines 58+) comprising a storage
portion/cavity 120, a smart chip device 20 (col. 4, lines 47+) which further contains an antenna
12 for contact-less I/O with reader/writer 200. The IC unit 40 of the smart device 1a contains a
30 sensor, which measures environmental parameters of the content (co. 7, lines 4+). The
information collected is transmitted to the host via non-contact interface 20 and antenna 12.

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Although Inose does not provide great detail, the product can be refilled via the product refilling device 550 (col. 7, lines 61+) as shown in figure 5. Since the product can be inks, toners (col. 1, lines 15+), the container is sealed in a manner the content may not leak as the smart device is hermetically sealed from the content.

5 Re claim 2 and 3, non-contact information medium 1a (col. 6, lines 59+) as shown in figure 4 comprises of a first component part 40, which contains sensor (col. 7, lines 4+) and a second component parts 12, 20 performing I/O operation with external device. In order to capture and transmit product environment data, they are electrically coupled.

10 Re claims 10 and 13, although Inose is silent on transporting the container, in the embodiment of recycling fuel or lubricating oil (col. 1, lines 15-23), one ordinary skill in the art can contemplate the container being transported to another location. Moreover, when the container is moved from one location to another, the measurable parameters can be taken before and after the transport, and further analyzed as desired by the users.

15 Re claims 11 and 12, since data interface 200 is reader/writer, information such as identification information can be retrieved and updated (see abstract; col. 3, lines 8-22).

 Re claim 14, Inose further provides information analysis wherein the measured data is compared against a particular standard (col. 2, lines 42-57).

20 Re claims 16 and 17, what can be stored and carried by the container is listed (col. 1, lines 15-23). However, it is Examiner's view that the container can hold any other material one chooses to carry. Since the embodiment/structure disclosed by Inose is capable of carrying snap-on material and organic polymer without structural modification, the reference still meets these claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

5 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10 This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later
15 invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 4-9 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inose (US 6,385,407) in view of Besprozvanny et al. (US 5,627,523). The teachings of Inose have
20 been discussed above.

Inose fails to specifically teach or fairly suggest of an assembly receiving cavity and dip tube for monitoring the measurable parameter of the content.

Besprozvanny teaches liquid level sensor device, which can be used in tanks (col. 1, lines 22+). The sensor is formed in the shape disk installed on the dip stick as show in figure 1.

25 In view of Besprozvanny's teaching, it would have been obvious to an ordinary skill in the art at the time the invention was made to employ well-known sensor, which can be used as a

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dipping to the teachings of Inose in order to obtain the data of the content in varying depths.

Although Inose's detector still provides an identification and status information of the content, since the unit is attached to the container, the content information (i.e., temperature, remaining amount) can erroneously incorrect or skewed. For example, depending on where the device is

5 installed, the reading can indicate the container is empty when in fact the container is partially filled with the product. Moreover, temperature can also be incorrect by measuring from the constant location. By utilizing dip stick device incorporating floater disk, as shown by Besprozvanny, accurate reading of these parameters can be obtained since sensor in the disk moves up/down with the liquid, and thus an obvious expedient.

10

Response to Arguments

4. Applicant's arguments filed on February 26, 2003 have been fully considered, but they are not persuasive.

15 Applicant argues that the Inose patent does not disclose the claimed invention (See page 6 thereafter). It is the Examiner's view that the Inose patent teaches a smart container assembly comprising a hermetically sealed storage cavity, a sensing mechanism, an I/O interface a recording mechanism electrically coupled to both the sensing mechanisms and I/O interface for recording data obtained from both the sensing mechanism and the I/O interface as described in
20 paragraph 3 above.

Applicant further contends that the Inose patent does not teach "a hermetically sealed storage cavity and a monitoring assembly that is not hermitically sealed and that is outside of the storage cavity " (page 7, 2nd paragraph).

In response to the Applicant's argument, Inose's container is used to contain and manage expendable product such as inks and toners (col. 1, lines 5+). Although Inose does not explicitly use the term "hermetically", in order to carry liquid material such as ink, the container is hermetically sealed storage device. Moreover, considering the identification device 20 is
5 hermetically sealed in the case 10, it would be reasonable that the whole container 100 and storage cavity 120 would be similarly treated. As further shown in figure 6, the resin case 10 can be installed in a recess 130 formed in a sidewall of the ink cartridge 100 (col. 8, lines 34+). Therefore, the identification device 20 is, in fact, outside the storage cavity 120.

With respect to the Applicant's assertion that Inose does not disclose I/O device, R/W
10 device 200 is a wireless I/O device interfacing with the tag 20 via antenna 12 (See figure 1 or the figure on the first page of Inose reference).

The Examiner further notes that the Applicant did not claim "a monitoring assembly that is not hermetically sealed" in any of the pending claims.

Applicant's arguments and the points distinguishing the teachings of cited references and
15 the claimed invention in instant application have been carefully considered, but they are not persuasive, and therefore, the Examiner has made this Office Action final.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time
20 policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (703)305-5203. The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax number directly to the Examiner is (703) 746-4782. The fax phone number for this Group is (703)308-7722, (703)308-7724, or (703)308-7382.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Ahshik Kim
Patent Examiner
Art Unit 2876
May 12, 2003


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